

Remarks/Arguments

Prior to the present amendment, claims 39-51 were pending in this application and were rejected on various grounds. Claims 39-43 and 48 have been canceled without prejudice or disclaimer. Claims 44 and 47 have been amended to recite "secreted polypeptide" instead of the term 'extracellular,' for clarity. Support for this amendment can be found in the specification on page 15-17 which discloses that PRO317 is a secreted protein and also in Figure 42, which shows that the signal sequence spans amino acids 1-18. The foregoing amendments to the claims are of formal nature, and do not add new matter. The rejection to the presently pending claims are respectfully traversed.

Priority

The Examiner asserts that Applicants are only entitled to the priority of the instant Application, dated July 16, 2001, since "the claimed subject matter does not have a substantial asserted utility or a well established utility." As will be apparent from the rest of the response, Applicants rely on the gene amplification assay (Example 92) for support of patentable utility. This data was first disclosed in the International application PCT/US98/18824, filed on 10 September, 1998, priority to which is claimed in the present application. Accordingly, Applicants believe that the effective filing date of this application is September 10, 1998.

Specification

The specification has been amended to remove references to hyperlinks or other browser-executable code and to reflect the changed address for ATCC, which are believed to overcome these objections.

Sequence compliance

Applicants have deleted the sequences on page 2, line 37 and page 14, line 17 and hence, Applicants believe that the application is now compliant with the sequence rules under 37 C.F.R. § 1.821-1.825.

Information Disclosure Statement

Applicants submit an IDS separately enlisting references recited in the Blast report in order to be compliant with 37 C.F.R. § 1.98(a)(1). Consideration of this Information Disclosure Statement is respectfully requested.

Claim Rejections – 35 USC § 112, first paragraph

Claims 39-43, 50, 51 are rejected under 35 U.S.C. §112, first paragraph, allegedly, for lack of enablement. Claims 39-43, 50, 51 are also rejected under 35 U.S.C. §112, first paragraph as failing to comply with the written description requirement.

In view of the cancellation of claims 39-43 and change of dependency of claims 50 and 51 on claim 44, this rejection is believed to be moot and must be withdrawn.

Claim Rejections – 35 USC § 112, second paragraph

Claims 39-44, 47, 48, 50, 51 are rejected under 35 U.S.C. §112, second paragraph for being indefinite. The Examiner noted that PRO317 was a soluble protein and hence the term "extracellular domain" was indefinite; in addition, the recitation of 'the extracellular domain' ... 'lacking its associated signal peptide' was also indefinite.

Cancellation of claims 39-43, 48 and the foregoing amendment to claims 44 and 47 and their dependent claims which recite "secreted" instead of "extracellular" are believed to overcome this rejection.

Claim Rejections – 35 USC § 102

(1) Claims 39-43, 50 are rejected under 35 U.S.C. § 102 (e) allegedly as being anticipated by Celeste (U.S.P.N. 6,027,917, filed December 10, 1997).

In view of cancellation of claim 39-43 and the change in dependency of claim 50 on claim 44, Applicants believe that this rejection has been obviated. Hence, this rejection should be withdrawn.

(2) Claims 39 is rejected under 35 U.S.C. § 102 (b) allegedly as being anticipated by Meno (dated May 1996).

Again, in view of cancellation of claim 39, Applicants believe that this rejection has been obviated. Hence, this rejection should be withdrawn.

(3) Claims 39-51 are rejected under 35 U.S.C. § 102 (a) allegedly as being anticipated by Ruben (publication date, February 25, 1999).

As discussed above, the effective filing date of this application is September 10, 1998. Since Ruben et al. is dated after the effective filing date of the present application, it is not prior art under 102(a) and this rejection should be withdrawn.

Claim Rejections – 35 USC § 103

Claims 39-42 are rejected under 35 U.S.C. § 102 (a) allegedly as being unpatentable over Kothapalli in view of Meno.

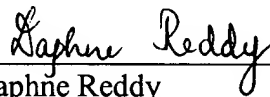
Again, in view of the cancellation of claims 39-42, Applicants believe that this rejection has been obviated. Hence, this rejection should be withdrawn.

The present application is believed to be in *prima facie* condition for allowance, and an early action to that effect is respectfully solicited.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 08-1641 (Attorney Docket No.: 39780-1618P2C17). Please direct any calls in connection with this application to the undersigned at the number provided below.

Respectfully submitted,

Date: December 2, 2003



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